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10/688,514

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Adam De Boor

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EXAMINER

BAROT, BHARAT

ART UNIT

PAPER NUMBER

2155

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/688,514

Applicant(s)

DE BOOR ET AL.

Examiner

Bharat N. Barot

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/7/06, 4/24/06, 11/24/06</u> | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

**CLAIM OBJECTION**

1. Claims 20 and 21 are objected to because of the following informality: Claims 20 and 21 contain "hander" in the last limitation, which is typographical error, examiner suggests that please replace " hander" with --handler--. Appropriate correction is required.

**NON-STATUTORY DOUBLE PATENTING**

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application, See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

### **OBVIOUSNESS-TYPE DOUBLE PATENTING**

3. Claims 20-22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 6, and 9 of U.S. Patent No. 6,173,316 in view of Judson (U.S. Patent No. 6,901,429).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims 1-2, 6, and 9 of U.S. Patent No. 6,173,316 recited all claimed limitations of the instant application claims 20-22 except an advertising content handler choosing an advertising page to be displayed when the communication device is idle and instructing the markup language content handler to display the advertising page chosen by the advertising content handler, but Judson explicitly teaches that the advertising content handler choosing an advertising page to be displayed when the communication device is idle and instructing the markup language content handler to display the advertising page chosen by the advertising content handler (figures 3 and 9-11; column 2 line 35 to column 3 line 8; and column 7 line 66 to column 9 line 53).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Judson as stated above with the communication device, method, and program product claimed in the claims 1-2, 6, and 9 of U.S. Patent No. 6,173,316 because it would have improved the transmission/access control of the web page and increased the utilization and efficiency of the communication device and its' memory by improving the transmission/access control.

**CLAIM REJECTIONS - 35 USC § 102(e)**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 23-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Judson (U.S. Patent No. 6,457,025). Judson's patent meets all the limitations for claims 23-47 recited in the claimed invention.

6. As to claim 23, Judson teaches a computer implemented method of displaying an advertising page for a communication device having a memory and a screen display (figure 2; and column 4 lines 24-54), the method including the steps of: receiving a markup language content and processing the markup language content to output the content to the screen display of the communication device, choosing an advertising page to be displayed when the communication device is idle; and displaying the advertising page as chosen on the screen display of the communication device (figures 3 and 9-11; column 2 line 35 to column 3 line 8; and column 7 line 66 to column 9 line 53).

7. As to claim 24, Judson discloses a browser program product for controlling the operation of a communication device by execution of the browser by a processor of the communication device having a screen display (figure 2; and column 4 lines 24-54), the browser program product comprising: a markup language content handler that receives a markup language content and processing the markup language content to output the content to the screen display of the communication device; an advertising content handler that displays an advertisement on the screen display of the communication device; and an advertising manager that prevents the advertisement from being displayed when a predetermined condition is satisfied (figures 3 and 9-11; column 2 line 35 to column 3 line 8; and column 7 line 66 to column 9 line 53).

8. As to claims 25-27, Judson discloses that the advertising manager prevents the advertisement from being displayed when a user responds to the advertisement, the advertisement has been displayed a predetermined number of times, and a more important advertisement is to be displayed (column 2 lines 35-59).

9. As to claims 28-29, Judson discloses that the advertising manager is capable of marking an advertisement as temporary, the marked advertisement being not stored on a URL history stack so that the advertisement is never rerun, and looks at a set of advertisements available and chooses one of the advertisements to display (figures 9-11; and column 7 line 66 to column 9 line 53).

10. As to claims 30-31, Judson does not disclose that the advertising manager checks whether a currently displayed advertisement is marked for deletion, advertisement manager deleting the advertisement if it is marked for deletion, and passes a string to the markup language content handler as user has responded to the advertisement after it is marked for deletion, which are inherently teaching by the Judson (see figures 9-11; and column 7 line 66 to column 9 line 53).

11. As to claims 32-33, Judson discloses that any key press that is not bound in the advertisement causes the advertisement to disappear, and the key press that is not bound in the advertisement causes the key press to be reprocessed by the page that was active before the advertisement appeared (column 9 line 29 to column 10 line 28).

12. As to claim 34, Judson discloses that the advertisement is a page described using a markup language and including an advertising content (column 2 lines 35-59; and column 8 line 55 to column 9 line 12).

13. As to claims 35-44, they are also rejected for the same reasons set forth to rejecting claims 24-27 and 34 above, since claims 35-39 are merely an apparatus and claims 40-44 are merely a method of operation for the program product defined in the claims 24-27 and 34.

14. As to claim 45, Judson teaches a computer implemented method for automatically displaying data to a user (see abstract; and figure 3), comprising: receiving a markup language page containing a tag including advertising data in a header portion of the page; and displaying a body portion of the markup language page in a window having a title bar area and the advertising data in the title bar area (column 5 lines 4-58; column 8 lines 24-54; and column 9 lines 29-53).

15. As to claims 46-47, they are also rejected for the same reasons set forth to rejecting claim 45 above, since claim 46 is merely a program product and claim 47 is an apparatus for the method of operation defined in the claim 45.



**CONTENT INFORMATION**

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Bharat Barot** whose Telephone Number is **(571) 272-3979**. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM. Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number **(571) 273-8300**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Saleh Najjar**, can be reached at **(571) 272-4006**.

Patent Examiner Bharat Barot

Art Unit 2155

September 21, 2006

*Bharat Barot*  
BHARAT BAROT  
PRIMARY EXAMINER